

# Notice of Allowability

Application N .

09/819,745

Examiner

James A. Meneffee

Applicant(s)

BUSHIDA ET AL.

Art Unit

2828

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 4/19/2004.
2. ☒ The allowed claim(s) is/are 9-20.
3. ☒ The drawings filed on 20 June 2001 and 19 March 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

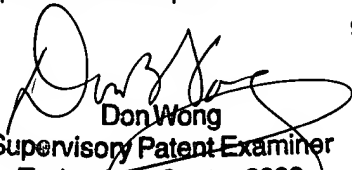
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

  
Don Wong  
Supervisory Patent Examiner  
Technology Center 2800

Art Unit: 2828

## **DETAILED ACTION**

### ***Response to Amendment***

In response to the amendment filed 4/19/2004, claims 9-12 are amended and claims 13-20 added. Claims 9-20 are pending.

### ***Allowable Subject Matter***

Claims 9-20 are allowed. The following is an examiner's statement of reasons for allowance:

It appears clear on the record that the applicant's invention is distinguishable over the prior art due to its manner of operation. See the prosecution history for details of how the claimed invention differs from the prior art. Throughout the prosecution the examiner's reliance on the Algots reference was based on the structure of Algots and the claimed invention being the same, and that even though their functions (i.e. the manner of operation of the devices) were different the functional limitations were not given weight. Now that the claims are drafted in either mean-plus-function format or as method claims, these functions can properly be given weight and these limitations are what distinguishes from Algots and the prior art. See the clarification below under the response to arguments.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

Applicant's arguments filed 4/19/2004 have been fully considered and are persuasive. However, clarification is necessary. Note that the apparatus claims 9-12 are interpreted to be in means-plus-function format even though there is not a recitation of the term "means." From the response of 4/19/2004, it is clear that the applicant intends to use the means-plus-function format. Further, it has been held that the term "means" or "step," while normally required for the terms to be interpreted in light of 35 U.S.C. § 112 6<sup>th</sup> par., is not required if it is clear that the limitations are being recited in terms of function, and not in terms of specific structures or acts.

[A] claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112 , sixth paragraph. MPEP 2181.

Thus, claims 9-12 herein are interpreted as falling under the (B) exception noted in the MPEP above. The claim limitations after the word "for" in these claims are written as a function to be performed, there is not sufficient structure, material, or acts to preclude the application of 112 sixth paragraph, and the applicant has stated the intention of having the claims follow the means-plus-function format. *See also Seal-Flex, Inc. v. Athletic Track & Court Construction*, 172 F.3d 836, 850, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999) (Radar, J., concurring) ("claim elements without express step-plus-function language may nevertheless fall within 112 6 if they merely claim the underlying function without recitation of acts for performing that function...In general terms, the underlying function of a method claim element corresponds to what that

Art Unit: 2828

element ultimately accomplishes in relationship to what the other elements of the claim and the claim as a whole accomplish. Acts, on the other hand, correspond to how the function is accomplished.”); *Personalized Media Communications LLC v. ITC*, 161 F.3d 696, 703– 04, 48 USPQ2d 1880, 1886– 87 (Fed. Cir. 1998); *Mas-Hamilton Group v. LaGard Inc.*, 156 F.3d 1206, 1213, 48 USPQ2d 1010, 1016 (Fed. Cir. 1998) (“lever moving element for moving the lever” and “movable link member for holding the lever...and for releasing the lever” were construed as means-plus-function limitations invoking 35 U.S.C. 112, sixth paragraph since the claimed limitations were described in terms of their function not their mechanical structure);

It is believed that this statement sufficiently clarifies the record to show that the examiner has interpreted claims 9-12, particular the “movable holder” and the “laser controller” in each of these claims, to fall under 35 U.S.C. § 112 paragraph 6, regardless of the lack of the terms “means” or “step,” and that it is proper to do so under the MPEP and the Federal Circuit.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Menefee whose telephone number is (571) 272-1944. The examiner can normally be reached on M-F 8:30-5.

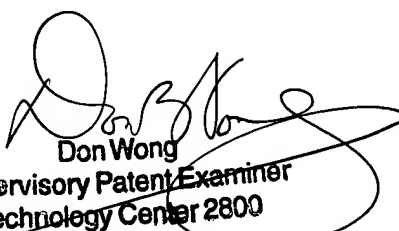
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2828

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JM  
May 21, 2004



Don Wong  
Supervisory Patent Examiner  
Technology Center 2800